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JOHN A. CHINONCHIO, ESQUIRE
SYNNESTVEDT & LECHNER LLP
1101 MARKET STREET, SUITE 2600
PHILADELPHIA PA 19107

COPY MAILED

JUN 24 2004

In re Application of
Glenn Bostock
Application No. 09/490,268
Filed: January 24, 2000
Title of Invention: Wall Paneling Assembly and
System

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition filed January 12, 2004 under 37 CFR 1.137(a).

The petition to revive under 37 C.F.R. § 1.137(a) is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This above-identified application became abandoned for failure to timely file an appeal brief in triplicate and submit the accompanying fee. Applicant filed a Notice of Appeal on July 16, 2001. Pursuant to 37 CFR 1.192(a) Applicant was required to file an Appeal brief two months from July 16, 2001. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on September 17, 2001. A Notice of Abandonment was mailed on August 14, 2001.¹

Petition to revive under 37 CFR 1.137(a)

A grantable petition under 37 C.F.R. § 1.137(a) must be accompanied by:

¹It should be noted the August 14, 2001 Notice of Abandonment was mailed prematurely.

- (1) the required reply,²
- (2) the petition fee,
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks item (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 C.F.R. § 1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 C.F.R. § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.³ However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case by case

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

³ The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee...at any time...if the delay is shown to the satisfaction of the Commissioner to have been unavoidable (emphasis added).

basis, taking all of the facts and circumstances into account."⁴ Nonawareness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP or Official Gazette notices, do not constitute unavoidable delay.⁵ The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof.

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.⁶

Application of the unavoidable standard to the present facts

In the present case, petitioner argues continued prosecution in the above-identified application was unavoidably delayed due to the neglect and inaction of his previous attorney Joseph Molasky. Petitioner contends despite calls to attorney Molasky, he did not discover the above-identified application was abandoned until December 11, 2003 when present counsel informed him of the status. Petitioner insist he was mislead by attorney Molasky in the October 17, 2001 letter which failed to mention an Advisory Action had been mailed on August 2, 2001 and a Notice of Abandonment was mailed on August 14, 2001. The fact that neither the Advisory Action or the Notice of Abandonment were mentioned leads Petitioner to conclude this information was deliberately withheld. Ultimately petitioner argues the actions or lack of actions of former attorney Molasky should not be imputed on petitioner because petitioner demonstrated diligence, petitioner had no knowledge his attorney could not be trusted with the prosecution of the application and petitioner was "continually and apparently

⁴ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

⁵ Id., 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982). (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute unavoidable delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. Lexis 23119, 13 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs through their counsel's actions or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications).

⁶ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

deliberately misled" as to the status of the application. Petitioner insist contrary to established precedence, he should not be bound by the actions or inactions of his representative. See In re Application of Robert Lonardo, 17USPQ2D (BNA) 1455.

The showing of record has been considered, but is not persuasive. The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions.⁷ Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a).⁸ Furthermore, petitioner is reminded that the Patent and Trademark Office is not the proper forum for resolving a dispute between petitioner and petitioner's representative.⁹

An adequate showing of unavoidable delay must include a showing from Attorney Molasky as to why action was not taken to prevent the application from becoming abandoned while the application was under Molasky's control. Petitioner should send a letter (accompanied by a copy of this decision) to Molasky by registered or certified mail, return receipt requested, indicating to Molasky that the USPTO is requesting his assistance in determining the circumstances surrounding the abandonment of this application, and is specifically requesting Molasky to provide a statement determining the circumstances surrounding the abandonment of this application, and is specifically requesting Molasky to provide a statement as to: (1) why an appeal in triplicate, appeal fee and any required extensions of time were not filed (2) when Molasky received the Advisory Action mailed August 2, 2001 and Notice of Abandonment which was mailed on August 14, 2001, and (3) what actions Molasky subsequently took upon learning that the application was abandoned. Such statements should be accompanied by copies of any documents (e.g. correspondence between petitioner and counsel) relevant to the outstanding Office action. In the event that Molasky fails to provide a statement within a period (e.g., within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to Molasky with any renewed petition under 37 CFR 1.137(a).

In addition to the above, petitioner needs to provide more detailed information to establish applicant acted diligently to prevent the application from going abandoned and since abandonment has acted as diligently as a reasonably prudent person would treat his most important business. What action if any beyond phone calls were made between October 2001 until June 2002. It appears that applicant did question the attorney's ability to prosecute the application at least as early as of June 2002.

⁷Link v. Wabash, 370 U.S. 626, 633-34 (1962).

⁸Haines v. Quiqq, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

⁹Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

Petitioner has not explained why petitioner continued to be represented by Molasky after petitioner lost confidence in attorney's representation. Nor has petitioner explained why he did not revoke his power of attorney to Molasky and appoint a new attorney until the filing of this petition on January 12, 2004. Once it was determined Molasky was not handling the application as petitioner desired, it is then petitioner's responsibility to either timely seek other counsel or prosecute the application on his own behalf. Beyond keeping a phone journal what did petitioner do to ascertain the status of the application.

Petitioner contends he did not discover the status of the application until December 2003. However, petitioner has not provided an explanation as to why he or any subsequent legal representative did not contact the USPTO directly to determine the status of the application.

In sum, petitioner has failed to provide sufficient evidence, to establish a finding of unavoidable delay.

Alternative Venue

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by the required reply, the required petition fee, and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

The filing of a petition under 37 C.F.R. § 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 C.F.R. § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 C.F.R. § 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306

By delivery service: U.S. Patent and Trademark Office
(FedEx, UPS, DHL, etc.) 220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (703) 306-0251.



Charlema R. Grant
Petitions Attorney
Office of Petitions